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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/775,599	02/05/2001	Joseph G. Gatto	23449-016	9235

909 7590 10/11/2005

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EXAMINER	
SUBRAMANIAN, NARAYANSWAMY	
ART UNIT	**PAPER NUMBER**
3624	

DATE MAILED: 10/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/775,599	GATTO, JOSEPH G.	
	Examiner	Art Unit	
	Narayanswamy Subramanian	3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 June 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-38 and 40-54* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3-23,38 and 51* is/are rejected.

7)☒ Claim(s) *24-37,40-50 and 52-54* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *6/27/2005*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This office action is in response to applicants' communication filed on June 27, 2005. The replacement drawings, amendments to the specification including abstract and claims 1, 8, 13-14, 20, 23-38 and 40-54 and cancellation of claims 2 and 39 made by the Applicant in his communication have been entered. Objections to the drawing and the abstract are withdrawn in view of the amendments. Double Patenting rejection made in the last office action has been withdrawn in view of the cancelled claims of the referenced application. Claims 1, 3-38 and 40-54 are pending in the application and have been examined. The rejections and response to arguments are stated below.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1, 3-38 and 40-54 are rejected under 35 U.S.C. 5 101 because the claimed invention is directed to non-statutory Subject matter.

35 USC 101 requires that in order to be patentable the invention must be a "new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof (emphasis added).

Claims 1, 3-38 and 40-54 are rejected under 35 U.S.C. 5 101 because the claimed invention is directed to a non-statutory subject matter. Specifically the method claim as presented does not claim a technological basis in the body of the claim. Without a claimed basis, the claim may be interpreted in an alternative as involving no more than a manipulation of an abstract idea and therefore non-statutory under 35 U.S.C. 101. In

contrast, a method claim that includes in the body of the claim structural / functional interrelationship which can only be computer implemented is considered to have a technological basis [See Ex parte Bowman, 61 USPQ2d 1669, 1671 (Bd. Pat. App. & Inter. 2001) - used only for content and reasoning since it is not precedential].

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1, 38 and 51 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 44 and 48 of U.S. Patent No. 09/524,253. Although the conflicting claims are not identical, they are not

patentably distinct from each other because they recite the means and steps that are substantially the same and that would have been obvious to one of ordinary skill in the art.

Claims 1 and 38 recite "displaying information relating to one or more analysts' estimates for a selected future event, comprising displaying simultaneously, on an analyst by analyst basis, for selected analysts, an indication of historical accuracy for an analyst based on selected criteria and the analyst's estimate for a future event" that are listed in claims 44, 46 and 48 of Gatto ('253). Predetermined earnings event is interpreted to include a future event.

Claim 51 recites "displaying information relating to security analysts' estimates, comprising displaying simultaneously, on an analyst by analyst basis, for selected analysts, an indication of historical accuracy for an analyst for one or more securities, the current estimate of a future event associated with the analyst for the one or more securities and model information relating to the analyst" that are listed in claims 44, 46 and 48 of Gatto ('253). How long an analyst has been following a security is interpreted as model information relating to the analyst and Predetermined earnings event is interpreted to include a future event.

These are provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be

patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 1, 3 and 6-38 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marshall (US Patent 6,073,115) in view of Lundgren (US Patent 5,608,620) as discussed in paragraph 9 of the last office action mailed on March 25, 2005.

Allowable Subject Matter

8. Claims 24-37, 40-50 and 52-54 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

9. In response to Applicant's arguments about 35 USC § 101 rejection, the amendment to the preamble fails to overcome this rejection. Specifically the method claim as presented does not claim a technological basis in the body of the claim. Without a claimed basis, the claim may be interpreted in an alternative as involving no more than a manipulation of an abstract idea and therefore non-statutory under 35 U.S.C. 101. In contrast, a method claim that includes in the body of the claim structural / functional interrelationship which can only be computer implemented is considered to have a technological basis.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention

where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to combine is the benefit that users would have received from combining the teachings. This motivation would have been obvious to one of ordinary skill in the art.

In response to applicant's argument that Lundgren does not teach the step of "analyst by analyst basis, for selected analysts: an indication of historical accuracy for an analyst based on selected criteria; and the analyst's estimate (or recommendation) for a future event", the examiner respectfully disagrees. Lundgren in Column 6 line 53-Column 7 line 18 discloses an indication of historical accuracy for an analyst based on selected criteria. In Column 6 lines 43-45 Lundgren discloses an analyst's estimate (or recommendation) for a future event. Lundgren is not relied upon to teach the step of displaying. Marshall teaches this step. Hence Marshall and Lundgren taken together each all the steps of the claims discussed.

Applicant's other arguments with respect to other claims have been considered but are not persuasive.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(a) Phillips et al (US Patent 6,792,399 B1) (September 14, 2004) Combination Forecasting Using Clusterization

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is (571) 272-6751. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (571) 272-6747. The fax number for Formal or Official faxes and Draft to the Patent Office is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PMR or Public PAIR. Status information for unpublished applications is available through Private PMR only. For more information about the PMR system, see http://pair-direct.uspto.gov. Should you

have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

N. Subramanian
September 25, 2005

HANI M. KAZIMI
PRIMARY EXAMINER